REMARKS

The Examiner has withdrawn the rejections under 35 U.S.C. §101. Although the Examiner has withdrawn the previous section 103 rejections of claims 1 through 66, he now rejects these claims based upon new grounds of rejection under 35 U.S.C. §103. In view of the above amendments and the following remarks, the applicants respectfully request the Examiner to reconsider the pending rejections.

First Group of the Section 103 rejections

The Examiner has rejected claims 1 through 8, 11 through 30, 33 through 52 and 55 through 66 under 35 U.S.C. §103 as being obvious over Dehlinger et al. in view of Cragun et al.

Independent claims 1, 19, 23 and 41 have been cancelled. In addition, their depedent claims 2 through 14, 20 through 36, 42 through 58 and 63 through 66 have been also cancelled. Previous dependent claims 15, 37 and 59 have been amended into independent claims, and dependent claims 16 through 18, 38 through 40 and 60 through 62 respectively depend from now independent claims 15, 37 and 59.

The rejections of claims 1 through 14, 19 through 36, 41 through 58 and 63 through 66 have now become moot since these claims have been cancelled. Currently pending claims are 15 through 18, 37 through 40 and 59 through 62. The following remarks are directed at these pending claims for overcoming the section 103 rejections in view of the Dehlinger et al. reference and the Cragun et al. reference.

Newly amended independent claims 15, 37 and 59 each explicitly recite "determining a database occurrence value based upon the first text database occurrence value and the second text database occurrence value in a predetermined manner so that

the word candidates substantially more occurring one of the first text database and the second text database but substantially less occurring in the other of the first text database and the second text database are avoided in the search words" and "the first text database containing certain vocabulary and sentences written in a certain style that are substantially different from those in the second text database." [emphasis added]. In other words, the invention as explicitly recited in newly amended independent claims 15, 37 and 59 efficiently searches the word candidates between the two databases or libraries of texts that are 'different" in "vocabulary" and sentence "style." The efficient search is realized by avoiding in the "search words" certain "word candidates" that appear more frequently in one text database but less frequently in the other database to be searched.

In view of the above explicitly recited patentable features, the applicants understand the disclosures of the cited prior art references in the following manner. The Examiner has cited the Dehlinger et al. reference. According to the characterization by the Examiner, the Dehlinger et al. reference discloses every subject matter limitations of previously dependent claims 15, 37 and 59 as Paragraph [0162] allegedly discloses a second text database. The alleged disclosure appears to be erroneous since the subject matter of claims 15, 37 and 59 calls for two separate values, "a first text database occurrence value" and "a second text database occurrence value." Paragraph [0162] discloses a single selectivity value that appears to correspond to a text database occurrence value.

For the lack of the limitations for specifying an area of a predetermined database, the Examiner has additionally cited the Cragun et al. reference and has pointed out Paragraphs [34] and [40] through [44]. The Cragun et al. reference discloses in Paragraph [34] that "the weight criteria utilized by the search engine may be categorized into the following categories: the format of the search term, the location of the search term in the candidate document, and the occurrence frequency of the search term in the candidate document."

DOCKET NO.: RCOH-1065   **PATENT**
Application No.: 10/650,444
Response to Final Rejection of June 6, 2007
Amendment dated September 5, 2007
Page 11 of 15

A search expression includes a search term having associated weight criteria. The weight criteria are associated with a specific search term and have characteristics related to formats such as BOLD and FONTSIZE, location in the text such as HEADER and SUMMARY. Thus, for example, when a given search term is found in multiple documents, the documents are sorted based upon the presence or absence of the weight criteria associated with the found searched term. The Cragun et al. reference discloses in Paragraphs [40] through [44] that it is determined whether or not the weight criteria are absent or present in the <u>already searched terms</u>. In other words, the word candidates are searched in all areas of every predetermined database.

The Cragun et al. reference fails to teach, disclose or suggest the above discussed patentable features of the current invention as explicitly recited in newly amended independent claims 15, 37 and 59.

The Dehlinger et al. reference generally discloses a "text-processing" and search system and method to search a certain words of interest in text databases or libraries. Initially, databases or libraries are generated from "processed text," which includes a list of non-generic words and text, library, text-specific word-specific identifiers associated with each word. (Paragraphs [0076] and [0077]). In addition, each words also has a selectivity value reflecting "the frequency occurrence in a library of text in a selected field, relative to the frequency of occurrence of the same word in one or more other libraries of text in one or more other fields." (Paragraph [0078]). The database generally contains "descriptive words" having a selectivity value above a predetermined threshold value. (Paragraph [0081]). After certain generic words and verb roots are removed from input text to generate non-generic words or target text, a search is made using the remaining terms having a selectivity value above a predetermined threshold value against the above described databases or libraries. (Paragraphs [0085] through [0087]).

It is not clear whether or not the cited references alone or combination teach, disclose or suggest certain patentable feature of the current invention as explicitly recited in newly amended independent claims 15, 37 and 59. For example, neither of the cited references fails to clarify the relationship between the search input and the database to be searched. Newly amended independent claims 15, 37 and 59 calls for "the first text database containing certain vocabulary and sentences written in a certain style that are substantially different from those in the second text database." [emphasis added]. Although the Dehlinger et al. reference discloses "patents" and "case reporters" as databases, no disclosure or suggestion is provided for forming appropriate search words for the above cross-database searches. In this regard, newly amended independent claims 15, 37 and 59 explicitly recites "the word candidates substantially more occurring one of the first text database and the second text database but substantially less occurring in the other of the first text database and the second text database are avoided in the search words."

As supported by the original disclosures on pages 12 through 14 of the current application under examination, the second preferred embodiment of the current invention two databases containing different vocabulary and styles such as a patent database and a newspaper database. (lines 28 and 29, page 12). Although the word frequency occurrence is small in one database, it is generally considered as useful as a search word, "the database occurrence determination unit 33 takes into account a difference in the occurrence value between the first text database 31 and the second text database 32 in determining the significance value." (lines 12 through 14, page 13). Consequently, the current invention provides that "a search word is not likely selected from words that are used frequently in the first text database 31 but are not frequently used in the second text database 32." (lines 10 through 12, page 14).

The Examiner may refer to the fact that the Dehlinger et al. reference discloses multi-tier search strategies for suggesting the above patentable feature of the current

invention. Only when the search results are not encouraging, the second-tier and or the third-tier searches are conducted using the words that were not initially used in the first search. (Paragraphs [0099] through [0101]). (Paragraphs [0180] and [0181]). These portions of disclosure are irrelevant to the patentable features of the current invention since the disclosure is related to the operations after the search words are already selected and tried. Quite contrarily, the patentable feature teaches away from this strategy of the subsequent multi-tier searches by "avoid[ing] the inclusion of certain "word candidates" in the "search words."

In addition to the above clear reasons for overcoming the pending section 103 rejections, the applicant would like to bring the following issues to the Examiner's attention on the use of the Dehlinger et al. reference as prior art.

The Dehlinger et al. reference is a US Patent Publication (US 2004/0006558 A1) (herein after also referred to as "the 558 publication"). The 558 publication has issued as US Pat 7,181,451 (the 451 patent) on February 20, 2007. According to the Public PAIR, the 558 publication is published from US application 10/261,971 (the 971 application) filed on September 30, 2002, which appears to have claimed on the transmittal letter priority from its provisional application No. 60/394,204 (the 204 parent provisional application) filed on July 5, 2002. On the other hand, the public PAIR also indicates the executed declaration refers to "PART C" for claiming the benefit under 35 U.S.C. §120, but no PART C appears to exist in the prosecution record. The 971 application also claims that it is a continuation of PCT Patent Application No. PCT/US02/21198 (the first PCT parent application) filed on Jul. 3, 2002 and a continuation of PCT Patent Application No. PCT/US02/21200 (the second PCT parent application) filed on Jul. 3, 2002.

The 558 publication has added additional disclosures on new matter over the 204 parent provisional application, the first PCT parent application and the second PCT

parent application.   For example, new matter includes alternative searches or the multi-tier searches, which were not disclosed in any of the 204 parent provisional application, the first PCT parent application or the second PCT parent application. Thus, the newly added disclosures do not gain the benefit of priority claim from the 204 parent provisional application, the first PCT parent application and the second PCT parent application.   The current US application under examination was filed on August 28, 2003 claiming the benefit of foreign priority of Japanese patent application 2002-250281 filed on August 29, 2002. The 971 application for the 558 publication was filed on September 30, 2002 after the current US application under examination. Since the 971 application contains newly added disclosures, the Dehlinger et al. reference cannot claim the benefit of priority for certain newly added disclosures including the multi-tier searches. For this reason, the Dehlinger et al. reference does not qualify as prior art for disclosing or teaching the multi-tier searches.

In view of the above patentable distinction, even if the two cited references are combined, the applicants respectfully submit to the Examiner that the combined disclosures still fail to teach, disclose or suggest the explicitly recited subject matter limitations of newly amended independent claims 15, 37 and 59. Thus, it would not have been obvious to one of ordinary skill in the relevant prior art to provide the above discussed patentable features of newly amended independent claims 15, 37 and 59 based upon the cited references alone or in combination.

Dependent claims 16 through 18, 38 through 40 and 60 through 62 ultimately depend from newly amended independent claims 15, 37 or 59 and incorporate the patentable features of the newly amended independent claims. Therefore, the applicants respectfully submit to the Examiner that the rejections of pending claims 15 through 18, 37 through 40 and 59 through 62 under 35 U.S.C. §103 as being obvious over Dehlinger et al. in view of Cragun et al. should be withdrawn.

<u>Second Group of the Section 103 rejections</u>

Furthermore, the Examiner has rejected claims 9, 10, 31, 32, 53 and 54 under 35 U.S.C. §103 as being obvious over Cragun et al. and Dehlinger et al. and further in view of Driscoll.

As already discussed above, claims 9, 10, 31, 32, 53 and 54 have been cancelled. Thus, the pending rejections of these claims have become moot.

<u>Conclusion</u>

In view of the above amendments and the foregoing remarks, Applicant respectfully submits that all of the pending claims are in condition for allowance and respectfully request a favorable Office Action so indicating.

Respectfully submitted,

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/KEN I. YOSHIDA/
Ken I. Yoshida, Esq.
Reg. No. 37,009

KNOBLE YOSHIDA & DUNLEAVY LLC
Customer No. 21302
Eight Penn Center, Suite 1350
1628 John F. Kennedy Blvd.
Philadelphia, PA 19103
Tel: (215) 599-0600